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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,530	02/11/2002	Kevin M. Liga	2050.141US1	6699

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EXAMINER	
LE, KHANH H	

ART UNIT	PAPER NUMBER
3688	

MAIL DATE	DELIVERY MODE
08/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/074,530	LIGA ET AL.	
	Examiner	Art Unit	
	KHANH H. LE	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 April 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-31 and 42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *25-31 and 42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *03/19/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to the correspondence of 04/10/2008. Claims 25-27 are amended, new claim 42 is added. Thus claims 25-31 are herein examined. Claims 25 and 42 are independent

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 25-31, 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

4. Claim 25:
It is not clear whether an ad location step is claimed with the newly added "wherein the first advertisement is located..." clause. Applicant seem to imply, with their arguments, that such a step is claimed. However, the clause is not given patentable weight as it is not positively recited, and does not impact the ad matching to a consumer profile step.

Correction is required. The step needs to be positively claimed.

(For prior art application, it is interpreted claim 25 has substantially the same scope as claim 26).

Claims 26-31 are rejected based on their dependency.

Claim 42 drawn to computer readable medium is similarly rejected since the same wherein clause does not affect the structure of the computer readable medium or other apparatus parts.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive. The previous rejection of Claim 25 under 35 U.S.C. 102(e) as being anticipated by Miller US 7266832 is withdrawn. New grounds of rejection are presented below. Applicants arguments are addressed therein.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 25-31, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller US 7266832 and further in view of Lazaridis US 7076244.

Claims 25-26, 42:

Miller discloses:

A method and computer readable medium for providing targeted advertising, comprising: compiling consumer profile information (col.8 lines 3-24: profiles of opted-in consumers or of non-opted ones for ads targeting);
determining whether a first advertisement matches the consumer profile information (col.8 line 22: ad targeting suggests matching with profiles); in the event that the first advertisement matches the consumer profile information, recording the first advertisement at the consumer location (col. 8 lines 25-38) onto a personal video recorder (col. 4 lines 21-23) ; and in the event that the first advertisement does not match the consumer profile information, ignoring the first advertisement (inherent).

However Miller does not disclose how to locate the first advertisement for recording to the PVR. That is Miller does not disclose determining whether the first advertisement is broadcast by a transmission center on a dedicated frequency; and if so, tuning a receiver to the dedicated frequency; if not, then scanning a set of broadcast frequencies to locate the first advertisement.

However, in analogous ad targeting art, Lazaridis teaches locating an appropriate ad targeted to a user by scanning many broadcast channels (Fig. 7 step 308 and associated text; col. 13 lines 34-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add that teaching of Lazaridis to Miller to allow locating an appropriate targeted ad when it is not known where the ad is located. It would also have been obvious to one skilled in the art that in the alternative, if a dedicated channel is known to provide such targeted ad, to tune a receiver to that channel, since that would have been a more efficient method to locate the ad.

Applicant argues Lazaridis at Figure 7 steps 302 and 308 teaches searching through all channels every time until there is no other channel to be searched. while *in claim 25,in contrast, if the first advertisement is located via a dedicated broadcast frequency from a transmission center, there is no need to scan the set of broadcast frequencies from the transmission center.*

It is noted even if Lazaridis discloses as argued, the Examiner had stated earlier and above " It would have been obvious to one of ordinary skill in the art at the time the invention was made to add that teaching of Lazaridis to Miller to allow locating an appropriate targeted ad when it is not known where the ad is located. It would also have been obvious to one skilled in the art that in the alternative, if a dedicated channel is known to provide such targeted ad, to tune a receiver to that channel, since that would have been a more efficient method to locate the ad."

In other words, the part of *Lazaridis* relied upon is the teaching of scanning many broadcast channels when needed to locate an ad. As stated earlier, in the alternative, if a dedicated channel is known to provide such targeted ad, to tune a receiver to that channel, would have been obvious, since that would have been a more efficient method to locate the ad. In other words, even if it's true that *Lazaridis* teaches scanning all channels, every time, as argued, a PHOSITA would have known to apply some common sense and adapt the teachings of LAZARIDIS only as necessary to their situation. Thus if an ad is known to be located on a dedicated channel, such knowledge derived from e.g. some source independent of scanning as done in LAZARIDIS or even, e.g. after scanning a few channels as done in LAZARIDIS , it would have been obvious to a PHOSITA to either not start the scanning or stop the scanning as appropriate because doing otherwise would have been inefficient or wasting resources.

Claims 27 and 28:

The combination of MILLER and LAZARIDIS discloses the method of claim 26 and MILLER further discloses:

playing a programming signal (col. 8 lines 39-44);

detecting a second advertisement in the programming signal (Figure 4 step 58; col. 8 lines 56-65) which has embedded data comprising information indicating the contents of the second advertisement. (MILLER's TV signal ads, col. 1 lines 50-53, have embedded data indicating the ads contents, e.g. a URL of the ad, see col. 1 lines 19-24, 28-38);

(note: embedding ad contents is also admitted art, e.g. specifications, US PGPub 2003/0154128 at [0023]; [0053])
determining whether the second advertisement should be swapped (Fig. 4 step 60; col. 8 lines 56-65) based on whether the second advertisement matches the consumer information profile (col. 8 lines 12-16 reads on determining that the second advertisement do not match the opted-in subscribers so swapping is necessary);
in response to determining that the second advertisement does not match the consumer information profile, retrieving the first advertisement; inserting the first advertisement in the programming signal; and playing the first advertisement (Fig. 4 step 62; col.9 lines 14-21, 28- 35).

Claims 29-31:

The combination of MILLER and LAZARIDIS modified as above discussed discloses the method of claims 27 or 28 and but does not specifically disclose wherein the step of determining whether the second advertisement matches the consumer information profile comprises: receiving and reviewing the embedded data; and comparing the contents of the second advertisement to the consumer information profile.
However it would have been obvious to one of ordinary skill in the art at the time the invention was made that the claimed steps would have been necessary to effect claims 27 and 28 as discussed above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday, Wednesday, and Friday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314)..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 4, 2008
/Khanh H. Le/
Examiner, Art Unit 3688

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688